



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/781,356 | 02/17/2004 | Jian-Qiang Fan | 04168/100M413-US1 | 9219 |
| 7278 | 7590 | 06/21/2006 | EXAMINER | |
| DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257 | | | SCHNIZER, RICHARD A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1635 | |

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|--|--|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/781,356 | Applicant(s) FAN, JIAN-QIANG | |
| | Examiner Richard Schnizer, Ph. D | Art Unit 1635 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-5,7-9,14-20,22-24,29-32 and 34-37.
 Claim(s) withdrawn from consideration: 6,10-13,21,25-28,33 and 38-40.

AFFIDAVIT OR OTHER EVIDENCE

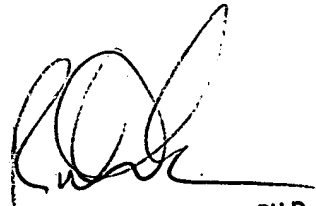
8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

Continuation of 5. Applicant's reply has overcome the following rejection(s): The obviousness rejections relying on any one of US 6,589,964, US 6,599,919, or US 6,774,135.

Continuation of 11. does NOT place the application in condition for allowance because: With regard to the obviousness rejections over Yew and Fan, Applicant's arguments at pages 12-16 of the response are unpersuasive. Applicant argues that there is no motivation to combine the references. First it is noted that these arguments were not presented prior to final rejection, and are unpersuasive for that reason alone. Further, the arguments are unpersuasive because they do not address the motivation stated in the rejection, i.e. one would have been motivated to combine the methods in order to obtain their benefits simultaneously. The motivation to combine references need not be stated explicitly in the references, but may be impliedly contained in the prior art or reasoned from knowledge available to one of ordinary skill. The expectation of some advantage, as in this case, is the strongest rationale for combining references. Applicant indicates that the rejection states a conclusion that is not even the subject matter of the claimed invention. However, Applicant has failed to point to any claimed method step that is not taught by the combined references. Applicant is reminded that the motivation to combine references may differ from that in the claimed invention and still render the invention obvious. In this case it would have been obvious to treat Fabry's disease with both of the patented methods simultaneously in order to obtain the benefits of each method. The results of the method steps are inherent. Applicant's allegation of hindsight reconstruction is not supported by evidence or logic. Applicant's arguments regarding claim 29 are unpersuasive. Applicant argues that the Fan patent teaches away from gene therapy because it is presented as an alternative to gene therapy. However, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). There is no reason of record why one would not be motivated to combine alternative methods in order to obtain the benefits of both. For these reasons the rejections are maintained.



RICHARD SCHNIZER, PH.D.
PRIMARY EXAMINER